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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,103	11/09/2000	Heinrich Gers-Barlag	BEIERSDORF 6	2589

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EXAMINER	
LAMM, MARINA	

ART UNIT	PAPER NUMBER
1616	8

DATE MAILED: 11/15/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/700,103	Applicant(s) GERS-BARLAG ET AL.	
	Examiner Marina Lamm	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Acknowledgment is made of the amendment filed 9/17/01. Claims pending are 7-16.

Claims 1-6 have been cancelled.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 7-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 09/700,102 in view of Defossez et al. (US 5,486,354). The difference between the instant claims and those of '102 is that the instant claims recite a combination of a triazine derivative with esters of *unbranched*-chain carboxylic acids and branched-chain alcohols, while the claims of '102 recite a combination of the triazine derivative with esters of *branched*-chain carboxylic acids and branched-chain alcohols. However, both esters of branched and linear carboxylic acids and branched-chain alcohols are used interchangeably for the same art-recognized purpose, as cosmetic oils. See Defossez et al. at col. 5, lines 10-15. Therefore, the claimed invention and that of '102 are obvious over each other.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Stäb et al. (US 5,620,680).

Stäb et al. teach cosmetic sun gel composition containing 2.5% of Uvinul T-150 and 18.9% of isopropyl myristate. See col. 12, Example 19. Sun gel of Stäb et al. is inherently applied to the skin for protecting the skin from damaging effects of light.

Thus, Stäb et al. teach each and every limitation of Claims 7-10 and 14.

5. Claims 7-11 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by Lüder (WO 98/52526).

Lüder teaches UV absorbent compositions comprising 3% of the triazine derivative of the instant invention (octyl triazone or Uvinul T-150) in combination with 2% of isopropyl myristate. See Example 4 on p. 9. Octyl triazone may be employed in amounts of from 0.5 to 15% by weight. See p. 3, lines 22-26. The UV absorbent composition of Lüder is inherently applied to the skin for protecting the skin from damaging effects of light.

Thus, Lüder teach each and every limitation of Claims 7-11 and 14.

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 11, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stäb et al.

Stäb et al. applied as above.

With respect to Claim 11, Stäb et al. do not explicitly teach the claimed concentration of the ester.

However, it would be conventional and within the skill of the art to identify the optimal concentration of the ester in order to achieve the desired properties of the final product.

With respect to Claims 12 and 15, Stäb et al. teach ethanol. See col. 12, Example 19. Stäb et al. also teach that alcohols such as ethanol and isopropanol can be used in their compositions as solvents. See col. 4, lines 41-42, 56-57.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to substitute ethanol for isopropanol in the composition of Example 19 with a reasonable expectation of deriving the same cosmetic effect as set forth in Example 19.

9. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lüder in view of Stäb et al.

Lüder applied as above.

Lüder does not explicitly teach the presence of the parent alcohol as claimed in Claims 12 and 15.

However, it is generally known to use isopropyl alcohol as a solvent is cosmetic compositions. See, for example, Stäb et al. at col. 4, lines 41-42, 56-57.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use isopropyl alcohol of Stäb et al. in combination with isopropyl myristate in compositions of Lüder, for its art-recognized purpose.

10. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Lüder or Stäb et al. in view of either Nguyen et al. or Defossez et al.

Lüder and Stäb et al. applied as above.

Neither reference explicitly teaches hexyldecyl laurate of the instant claims.

11. However, hexyldecyl laurate is conventionally used for the same art-recognized purpose as the esters of Lüder and Stäb et al., that is as a cosmetic oil. See Nguyen et al. at col. 11, line 11 or Defossez et al. at col. 5, lines 10-14.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use hexyldecyl laurate of Nguyen et al. or Defossez et al. in the compositions of Lüder or Stäb et al. for its art-recognized purpose. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

12. Applicant's arguments filed 9/17/01 have been fully considered but they are not persuasive.

With respect to the double patenting rejection, the applicant argues that "the patent issuing on the instant application is scheduled to expire the same date as the patent issuing from copending Application No. 09/700,102, and, thus, there should not be any unjustified time wise extension of monopoly and consequently, no double patenting." In response, it is noted that the purpose of double patenting rejection is not only to prevent unjustified time wise extension of monopoly, but also "to prevent possible harassment by multiple assignees." See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

13. In response to the applicant's argument that the Lüder and Nguyen et al. references are not prior art because their effective dates are after the instant foreign priority date, it is noted that the applicant cannot rely upon the foreign priority papers to overcome the rejections over either Lüder or Nguyen et al. because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Conclusion

14. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml
11/6/01

JOSE' G. DEES
SUPERVISORY PATENT EXAMINER
1616